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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,023	03/02/2004	Michel Strebelle	P06745US02/BAS	9734
881 7590 08/03/2009 STITES & HARBISON PLLC 1199 NORTH FAIRFAX STREET SUITE 900 ALEXANDRIA, VA 22314				
EXAMINER				
PATEL, DEVANG R				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/790,023

Applicant(s)

STREBELLE ET AL.

Examiner

DEVANG PATEL

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2009.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13 and 14 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-11, 13-14 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/17/09 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 1-3, 5-7, 9-11 and 13-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Grosch et al. (DE 19623611, of record) and in view of Hefele et al. (WO 98/37965), and further in view of Sepulveda et al. (US 4613427, of record). *US 6458970 is taken to be the English-equivalent of WO 98/37965 and sections cited in the rejections below refer to the US Patent 6458970.*

a. **Regarding claim 1**, Grosch et al. ("Grosch") discloses a process for preparation of epoxides comprising reacting an olefinic with a peroxide in the presence of an epoxidation catalyst (abstract, pg 1) obtained by blending a

mixture including a titanium zeolite powder, water, binder, molding assistants such as methyl cellulose, which acts as a plasticizer (examples). Grosch appreciates that auxiliary agents can be added for extrusion shaping process, the usual one being methyl cellulose (pg. 1).

Grosch does not expressly disclose a pore-forming substance that is distinct from the plasticizer. Hefe et al. ("**Hefe**", drawn to titanium-based oxidation catalyst) discloses adding various auxiliary agents to the paste-like mass for catalyst production including binders and pore formers (col. 6, lines 51-53). Specifically, Hefe discloses pore formers such as cellulose, starch, oxalic acid, melamine or urea. Hefe further teaches that the type and amount of the auxiliary agents generally depends on the chemical composition of the active catalyst in question, the starting materials, and is advantageously optimized in an experiment for a particular catalyst composition to be produced in each case (col. 7, lines 7-19). In view of that, it would have been obvious to a person of ordinary skill in the art at the time of the invention to add one or more pore formers of Hefe in the oxidation catalyst of Grosch in order to obtain desired activity of the catalyst composition. Moreover, the claim would have been obvious to an artisan since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

Neither Grosch nor Hefe teaches an amount of 6-14 wt% of pore-forming substance. However, **Sepulveda** discloses exemplary pore-forming

substances such as carbon, wood powder, polyethylene glycol, cellulose, methylcellulose, or melamine (similar to Hefele), in order to produce the optimum pore volume in the final catalyst (col. 4, lines 15-25). Sepulvada also discloses providing 8-30 wt% of pore-forming substance prior to extrusion. In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists (MPEP 2144.05). It is also noted that similar to Grosch, Sepulvada further discloses the steps of extrusion and calcination to obtain final catalyst in the form of extrudates (col. 4, lines 25-45). The claim would have been obvious because choosing 6-14 wt% of pore former would have yielded the predictable results of obtaining an optimum pore volume to a person of ordinary skill in the art at the time of the invention.

Grosch teaches shaping the paste obtained above by extrusion and drying in order to remove at least some of water and calcining to remove at least some of the organic residues, forming pores and obtaining extruded granules (pg. 1).

b. **As to claim 2**, Grosch discloses the titanium zeolite having a crystalline structure of the ZSM-5, 11 type, wherein there is 10 wt% binder chosen from silicon derivative and converted into catalyst matrix (pg 2).

c. **As to claim 3**, Grosch discloses the titanium zeolite having an IR absorption at about 960 cm^{-1} (example 1).

d. **As to claim 5**, Grosch discloses cylindrical extruded granules with 2 mm diameter and length of 1-8 mm (examples).

- e. **As to claim 6**, the catalyst of Grosch contains from 1-99 wt% titanium zeolite, the remainder being matrix.
- f. **As to claims 7 and 11**, Grosch discloses methyl cellulose (plasticizer) is a polysaccharide and binder includes siloxane derivative.
- g. **As to claim 9**, the amount of methyl cellulose in Grosch is between 1-10 wt% (examples).
- h. **As to claims 10 and 13**, Sepulveda discloses a pore-forming substance (melamine) in an amount from 5-40 wt% to obtain an optimum pore volume in the final catalyst (col. 4, lines 20-25). The base material with respect to catalyst of Grosch is titanium zeolite. Grosch in view of Hefele and Sepulveda meets the claimed amount of 5-35 wt% relative to the weight of titanium zeolite. It would have been obvious to one of ordinary skill in the art at the time of the invention to choose the instantly claimed weight ranges through process optimization, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.
- i. **Regarding claim 14**, Grosch discloses a process for preparation of propylene oxide (i.e. 1, 2 epoxypropane) comprising reacting propen (i.e. propylene) with hydrogen peroxide in the presence of an epoxidation catalyst (pg 2) obtained by blending a mixture including a titanium zeolite powder, water, binder, molding assistants such as methyl cellulose, which acts as a plasticizer

(examples). Grosch appreciates that one or more auxiliary agents can be added for extrusion shaping process, the usual one being methyl cellulose (pg. 1).

Grosch does not expressly disclose a pore-forming substance that is distinct from the plasticizer. Hefelet al. ("**Hefelet**", drawn to titanium-based oxidation catalyst) discloses adding various auxiliary agents to the paste-like mass for catalyst production including binders and pore formers (col. 6, lines 51-53). Specifically, Hefelet discloses pore formers such as cellulose, starch, oxalic acid, melamine or urea. Hefelet further teaches that the type and amount of the auxiliary agents generally depends on the chemical composition of the active catalyst in question, the starting materials, and is advantageously optimized in an experiment for a particular catalyst composition to be produced in each case (col. 7, lines 7-19). In view of that, it would have been obvious to a person of ordinary skill in the art at the time of the invention to add one or more pore formers of Hefelet in the oxidation catalyst of Grosch in order to obtain desired activity of the catalyst composition. Moreover, the claim would have been obvious to an artisan since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

Neither Grosch nor Hefelet teaches amount of 6-14 wt% of pore-forming substance. However, **Sepulveda** discloses exemplary pore-forming substances such as carbon, wood powder, polyethylene glycol, cellulose, methylcellulose, or melamine (similar to Hefelet), in order to produce the optimum pore volume in the

final catalyst (col. 4, lines 15-25). Sepulveda also discloses providing 8-30 wt% of pore-forming substance prior to extrusion. In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists (MPEP 2144.05). It is also noted that similar to Grosch, Sepulveda further discloses the steps of extrusion and calcination to obtain final catalyst in the form of extrudates (col. 4, lines 25-45). The claim would have been obvious because choosing 6-14 wt% of pore former would have yielded the predictable results of obtaining an optimum pore volume to a person of ordinary skill in the art at the time of the invention.

Grosch teaches shaping the paste obtained above by extrusion and drying in order to remove at least some of water and calcining to remove at least some of the organic residues, forming pores and obtaining extruded granules (pg. 1).

2. **Claims 4 and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Grosch et al. (DE 19623611, of record) in view of Hefele et al. (US 6458970) and Sepulveda et al. (US 4613427, of record), and further in view of Balducci et al. (US 5965476, of record).

j. **As to claim 4**, none of the references above explicitly disclose the claimed formula. However, **Balducci et al.** (drawn to silica/zeolite composite preparation process) discloses titanium-silicalites catalysts satisfying the general formula $x\text{TiO}_2(1-x)\text{SiO}_2$, with x varying from 0.0005-0.04. It would have been obvious to a person of ordinary skill in the art at the time of the invention to use

titanium silicalites having the claimed formula because they provide a particular selectivity in epoxidation reactions of olefins (col. 1, lines 13-18).

k. **As to claim 8**, Grosch discloses the powder having 60 mesh particle size distribution, but this is much larger than 10 micron. Balducci discloses that the silica/zeolite composite materials have particular selectivity in epoxidation reactions of olefins as stated in claim 4 above. Balducci discloses both titanium-silicalites and beta zeolites, in powder form, having submicronic particles of <1 micron. Thus, it meets the limitation of powder having a mean diameter of less than 10 micron. Balducci further discloses that these materials are typically subjected to granulation processes, wherein the form and dimensions of the granules are dependent on various factors such as type of reactor, mass transport or heat phenomena limitations, or to control load losses of the catalytic bed (col. 1, lines 31-40). It would have been obvious to one of ordinary skill in the art at the time of the invention to choose the instantly claimed mean diameter of <10 micron through process optimization, since the dimensions are made suitable according to reactor type, mass transport or heat phenomena limitations, or to control load losses of the catalytic bed.

Double Patenting

Claims 1-14 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,699,812 in view of Grosch et al. (DE 19623611), as explained in the previous office action.

****Applicant states that a terminal disclaimer is submitted with the amendment, however, such does not appear on record.****

Response to Amendment and Arguments

Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection set forth above.

Conclusion

Claims 1-14 are rejected.

The rejections above rely on the references for all the teachings expressed in the text of the references and/or one of ordinary skill in the art would have reasonably understood from the texts. Only specific portions of the texts have been pointed out to emphasize certain aspects of the prior art, however, each reference as a whole should be reviewed in responding to the rejection, since other sections of the same reference and/or various combinations of the cited references may be relied on in future rejections in view of amendments.

Applicant is reminded to specifically point out the support for any amendments made to the disclosure. See 37 C.F.R. 1.121; 37 C.F.R. Part 41.37; and MPEP 714.02.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEVANG PATEL whose telephone number is (571)270-3636. The examiner can normally be reached on Monday thru Thursday, 8:00 am to 5:30 pm, EST..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jessica Ward can be reached on 571-272-1223. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. P./

Examiner, Art Unit 1793

/Jessica L. Ward/

Supervisory Patent Examiner, Art Unit 1793